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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,149	12/01/2003	Takashi Nakatsuyama	50N3175.02	1767
2774 7590 09/24/2007 MAYER & WILLIAMS PC 251 NORTH AVENUE WEST 2ND FLOOR WESTFIELD, NJ 07090			EXAMINER BOSS, BROCK N	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 09/24/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/725,149	<b>Applicant(s)</b> NAKATSUYAMA, TAKASHI	
	<b>Examiner</b> Brock N. Boss	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/10/2003</u>  | 6) <input type="checkbox"/> Other: ____                           |

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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claim 1-20** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over *claims 1-20* of U.S. Patent No. 6,658,231 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions of descriptions of the same subject matter varying in breadth. For example, note the following relationship between the instant application claims and the patented claims

a) the “method for receiving in a broadcast system, at a receiver having a unique identification number, only designated information” in the preamble of the application in claim 1 corresponds to “a memory coupled to the logic unit, wherein the memory contains data

representing a unique identification number associated with the receiver” in the preamble of the patent in claim 1.

b) the claimed “monitoring a broadcast index signal containing tuning data; detecting the unique identification number associated with the receiver in the broadcast index signal; downloading the tuning data subsequent to detecting the unique identification number in the detecting step; storing the downloaded tuning data in memory; and tuning and receiving a program signal containing program data associated with a program using the tuning data stored in said storing step.” of application claim 1 corresponds to “the receiver is configured to monitor a broadcast index signal containing tuning data, to download and store in the memory the tuning data subsequent to detecting the unique identification number associated with the receiver in the broadcast index signal, and to used the stored tuning data to receive a program signal containing program data associated with a program” of patented claim 1.

**Claims 2-9** of the application correspond to claims 2-9 of the patent.

**Claim 10-13** of the application correspond to claims 14-17 of the patent.

Regarding **claim 14**, although the conflicting claims are not identical, they are not patentably distinct from each other because the application is a method and the patent is an information system, which includes all the corresponding functions.

For example, note the following relationship between the instant application claims and co-pending application claims:

a) the “method for requesting and receiving designated information in a broadcast system, at a first transceiver having a unique identification number, the method comprising the steps of:” in the preamble of the application in claim 1 corresponds to “An information system

transceiver comprising: a logic unit, a memory coupled to the logic unit, wherein the memory contains data representing an identification an identification number associated with the receiver” in the preamble and body of the patent in claim 10.

b) the claimed “transmitting from the first transceiver to a wireless communication system a request signal, the request signal including the unique identification number and a request for a program; receiving at the first transceiver, from the wireless communication system, a broadcast index signal containing tuning data; storing the tuning data in memory; receiving a program signal containing program data, associated with a program, using the stored tuning data; and transmitting at least a portion of the stored tuning data from the first transceiver to a second transceiver. “ of application claim 1 corresponds to “a tuning system coupled to the logic unit, and a transmitter coupled to the logic unit, wherein the transceiver is configured to transmit to a wireless communication system a request signal, the request signal including the identification number and a request for a program, to receive from the wireless communication system an index signal including the tuning data and to store the tuning data in the memory, and to use the stored tuning data to receive a program signal containing a program, and further wherein the transceiver is configured to transmit at least a portion of the stored tuning data to a second transceiver” of patented claim 10.

Regarding **claim 15**, although the conflicting claims are not identical, they are not patentably distinct from each other because the application is computer implemented and the patent is a receiver, which includes all the corresponding functions.

For example, note the following relationship between the instant application claims and co-pending application claims:

a) the “computer readable medium for receiving in a broadcast system, at a receiver having a unique identification number, only designated information, said computer readable medium containing program instructions that, when loaded into a processor, cause the processor to perform the steps of” in the preamble of the application in claim 1 corresponds to “a memory coupled to the logic unit, wherein the memory contains data representing a unique identification number associated with the receiver” in the preamble of the patent in claim 1.

b) the claimed “monitoring a broadcast index signal containing tuning data; detecting the unique identification number associated with the receiver in the broadcast index signal; downloading the tuning data subsequent to detecting the unique identification number in the detecting step; storing the downloaded tuning data in memory; and tuning and receiving a program signal containing program data associated with a program using the tuning data stored in said storing step.” of application claim 1 corresponds to “the receiver is configured to monitor a broadcast index signal containing tuning data, to download and store in the memory the tuning data subsequent to detecting the unique identification number associated with the receiver in the broadcast index signal, and to used the stored tuning data to receive a program signal containing program data associated with a program” of patented claim 1.

**Claim 16** of the application corresponds to claim 2 of the patent.

Referring to **claim 17**, although the conflicting claims are not identical, they are not patentably distinct from each other because the application is computer implemented and the patent is an information system, which includes all the corresponding functions.

For example, note the following relationship between the instant application claims and co-pending application claims:

a) the “method for requesting and receiving designated information in a broadcast system, at a first transceiver having a unique identification number, the method comprising the steps of:” in the preamble of the application in claim 1 corresponds to “An information system transceiver comprising: a logic unit, a memory coupled to the logic unit, wherein the memory contains data representing an identification an identification number associated with the receiver” in the preamble and body of the patent in claim 10.

b) the claimed “transmitting from the first transceiver to a wireless communication system a request signal, the request signal including the unique identification number and a request for a program; receiving at the first transceiver, from the wireless communication system, a broadcast index signal containing tuning data; storing the tuning data in memory; receiving a program signal containing program data, associated with a program, using the stored tuning data; and transmitting at least a portion of the stored tuning data from the first transceiver to a second transceiver. “ of application claim 1 corresponds to “a tuning system coupled to the logic unit, and a transmitter coupled to the logic unit, wherein the transceiver is configured to transmit to a wireless communication system a request signal, the request signal including the identification number and a request for a program, to receive from the wireless communication system an index signal including the tuning data and to store the tuning data in the memory, and to use the stored tuning data to receive a program signal containing a program, and further wherein the transceiver is configured to transmit at least a portion of the stored tuning data to a second transceiver.” of patented claim 10.

**Claims 18-19** of the application correspond to claims 8-9 of the patent.



Regarding **claim 20**, although the conflicting claims are not identical, they are not patentably distinct from each other because the application is a computer implemented and the patent is an information system, which includes all the corresponding functions.

For example, note the following relationship between the instant application claims and co-pending application claims:

a) the “computer readable medium for requesting and receiving designated information in a broadcast system, at a first transceiver having a unique identification number, the method comprising the steps of:” in the preamble of the application in claim 1 corresponds to “An information system transceiver comprising: a logic unit, a memory coupled to the logic unit, wherein the memory contains data representing an identification an identification number associated with the receiver” in the preamble and body of the patent in claim 10.

b) the claimed “transmitting from the first transceiver to a wireless communication system a request signal, the request signal including the unique identification number and a request for a program; receiving at the first transceiver, from the wireless communication system, a broadcast index signal containing tuning data; storing the tuning data in memory; receiving a program signal containing program data, associated with a program, using the stored tuning data; and transmitting at least a portion of the stored tuning data from the first transceiver to a second transceiver. “ of application claim 1 corresponds to “a tuning system coupled to the logic unit, and a transmitter coupled to the logic unit, wherein the transceiver is configured to transmit to a wireless communication system a request signal, the request signal including the identification number and a request for a program, to receive from the wireless communication system an index signal including the tuning data and to store the tuning data in the memory, and

to use the stored tuning data to receive a program signal containing a program, and further wherein the transceiver is configured to transmit at least a portion of the stored tuning data to a second transceiver” of patented claim 10.


### **Conclusion**

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brock N. Boss whose telephone number is (571) 270-1660. The examiner can normally be reached on Monday-Thursday 9:30-7:30 Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BB 9/14/2007



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